

REMARKS

Reconsideration and allowance of this application are respectfully requested in light of the following remarks.

I. Rejection of Claim 12 Under 35 U.S.C. §112, ¶2.

The Office Action Position

The Office Action alleges that Claim 12 is indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In support of this allegation, the Office Action alleges that Claim 12 recites

"database accessing by said associated at least one of said plurality of roles...".

The Office Action further alleges that Claims 6 and 10, which Claim 12 depends on, recites

"...template being associated with....by at least one of said plurality of business rules", "...plurality of entries and associated business rules", "...plurality of components and associated business rules", "...roles being associated with each said Ad Box...", etc.

The Examiner alleges that it is not clear what the said associated is referred to.

Applicants Response

Applicants respectfully traverse.

Claim 6 recites, in pertinent part:

"...a plurality of business rules governing preparation and administration of ads, ..., each of said plurality of entries defined by said at least one default Ad Box

template being associated with and controlled by at least one of said plurality of business rules, and each of said plurality of components defined by said at least one Ad Master template being associated with and controlled by at least one of said plurality of business rules."

The limitation clearly recites that each entry of an Ad Box template is associated with and controlled by at least one business rule and that each component of an Ad Master template is associated with and controlled by at least one business rule. Claim 6 further recites storing in a database the association between Ad Box template entries and business rules (lines 12-13) as well as the associated between Ad Master template components and business rules (lines 14-15).

Claim 10 recites

"...a plurality of roles for preparation and administration of ads, ... , at least one of said plurality of roles being associated with each said Ad Box default template, and at least one of said plurality of roles being associated with each said Ad Master template; ..."

The limitation clearly recites that each Ad Box default template is associated with at least one of said plurality of roles and that each Ad Master template is associated with at least one of said plurality of roles. Claim 10 further recites storing in a database the association between Ad Box default templates and roles (lines 8-9) and the association between Ad Master templates

and roles (lines 8-9).

Four different associations are being claimed by present Claims 6, 10 and 12: (1) an association between roles and Ad Box default templates, (2) an association between roles and Ad Master templates, (4) an association between business rules and entries of Ad Box default templates, and (4) an association between business rules and components of Ad Master templates. The term "association" describes the relationship since a business rule (role) may be associated with more than one entry or component (template) and the relationship may change, e.g., be deleted or added for an entry or component (template) at any time. Further, the same rule (role) may be associated with both an entry (Ad Box default template) and a component (Ad Box Master template).

Claim 12 recites, in pertinent part:

"...database accessing by said associated at least one of said plurality of roles to at least one of said Ad Box default templates...

database accessing by said associated at least one of said plurality of roles to said at least one Ad Master Template..."

The phrase "said associated" modifies whatever follows, e.g., "said associated at least one of said plurality of roles" or "said associated business rules". The phrase "said associated" does not stand on its own just like the phrase "a plurality of" does not

stand on its own but modifies whatever follows it. Further, what is being accessed in the database is also recited so that the limitation explicitly recites what is being accessed (Ad Box default template or Ad Master template) and by what item associated with what is being accessed it is being accessed by (one of said plurality of roles associated with the Ad Box Default template or the Ad Master template). The claim language of Claims 6, 10 and 122 is so specific that there is no confusion possible between business rules that are associated with entries of an Ad Box Default template and business rules that are associated with components of an Ad Master template.

Therefore, contrary to the assertion of the Office Action, Applicants assert that it is clear what "associated roles" and "associated rules" are referring to. Roles are associated with templates and rules are associated with constituent parts of templates, as recited by present Claims 6, 10 and 12 and discussed above.

In view of the foregoing discussion, Applicants assert that Claim 12 is not indefinite, and respectfully request that the rejection be withdrawn.

II. Claims 1-4, 20, 25 and 26 are rejected under 35 U.S.C.

\$103(a) as being unpatentable over Kashino (U.S. Patent No. 6,166,716, in view of ILOG JRules Software as taught by Article "New ILOG JRules Software is First to Bring Business Rule Creation to Business People" PR Newswire; New York; Apr 5, 2000, (Hereinafter "ILOG").

The Office Action Position

The Office Action alleges that Kashino teaches company advertiser and ad publisher personnel roles to accomplish preparation of ads for publication (col. 8 line 48 to col. 9 line 28) and preparation and administration of ads for publication by said roles according to business rules (see FIG. 7 and related columns). The Office Action admits that Kashino does not teach specifying business rules to control preparation and administration of ads for publication and storing the rules and personnel roles in a database. The Office Action alleges that ILOG teaches specifying customized business rules for specific applications or industry. The Office Action further alleges that ILOG teaches specifying business rule definition and implementation as well as workflow management, logistics and exchanges (page 1-3 of ILOG press release). The Office Action also alleges that both Kashino and ILOG teach networked, distributed and replicated database (Kashino col. 8 line 48 to col. 9 line 28 and ILOG page 3).

Applicants Response

At the outset Applicants assert that the hyperbole of a press release is not a teaching, but a marketing device containing exaggerated, i.e, puffing-type statements concerning capabilities of a then (at the time of the press release) as yet to be released product (see pricing and availability on page 3). That this is the case is supported by (1) "Forward-Looking Information" et seq, at the bottom of page 3 and continuing on the top of page 4 of the press release as well as (2) Applicants observation that a business organization relying on a business rules application is going to have that application under strict configuration control. Strict configuration control, as practiced by anyone ordinarily skilled in the art means that changes are not made to an operation system (business rules system) by those not ordinarily skilled in the art, as suggested by the ILOG JRules press release. Typically, all changes are submitted to a maintenance organization that maintains the business rules application, are evaluated and approved/disapproved, implemented if approved and TESTED to insure the changes work and are compatible with existing business practices. This change implementation is never done by business analysts and end users because it would result in a non-working business rules system. So that the claim in the "New ILOG JRules Software" press release that their new capabilities bring this

technology beyond just highly skilled developers to a wider community of business analysts and end users is just hype. No organization with an investment in a business rules application is going to risk their system's integrity and operation by allowing such a wider community (of individual not ordinarily skilled in the art) to change it.

With regard to roles, at the reference cited by the Office Action (col.8 line 48 to col. 9 line 28), (1) Kashino does not teach specifying company advertiser and ad publisher personnel roles to accomplish preparation and administration of ads for publication; and (2) Kashino does not teach any advertiser roles, both as recited by present independent Claims 1 and 20, but merely states that correcting work is done by an advertiser who participate (sic) in this publishing work (col. 9 lines 21-24). At most, Kashino teaches ad creation (editor) and correction roles (designer and copy writer) for publisher personnel (col. 9 lines 25-28).

With regard to business rules, the Office Action has provided a reference that defines business rules as "statements of business policies and procedures that drive day-to-day business activity" (ILOG, page 2, line 15). Kashino teaches at FIG. 7 and related columns, an ad preparation system comprising an advertiser

who places an order for an ad with an advertisement agency that gives an instruction to a publishing company so as to prepare contents of advertisement in comply with the need of the advertiser, a publisher editor in charge prepares advertisement pages in accordance with the advertiser's demand with being helped by an external designer or copy writer, and the ad is finally sent to a printing company for printing. The advertiser's demand is not a business rule, according to the definition provided by the Office Action. It is a one-off requirement for a particular ad, in this case for a mail order ad in a magazine. Contrary to the allegation of the Office Action, nowhere does Kashino teach preparation and administration of ads by company advertiser and publisher personnel roles according to specified business rules, as recited by independent Claims 1 and 20.

ILOG does not remedy any of these deficiencies of Kashino. Nowhere does the ILOG press release even mention roles or specifying roles for preparing a product and administering the product preparation process. While ILOG does provide a business rules engine and a business rule definition language that is customizable to a given industry, Kashino cannot be modified to employ such business rule definition language and business rules engine since Kashino does not anywhere teach employing business

rules. Kashino only teaches following and advertiser's demand (requirements).

Regarding the allegation of the Office Action that ILOG teaches specifying business rule definition and implementation as well as workflow management, logistics and exchanges (pages 1-3), Applicants respectfully point out the ILOG press release only states "Sophisticated new features in ILOG JRULES 3.0 simplify business rule definition and implementation for these applications [B2B e-business applications], as well as [for] workflow management, logistics and exchanges." The press release does not state that ILOG JRules 3.0 provides workflow management, logistics and exchanges as alleged by the Office Action.

As regards the Office Action allegation that both Kashino and ILOG teach networked, distributed and replicated databases nowhere do either Kashino or ILOG even mention distributed, replicated databases let alone networked databases. At the cited reference, Kashino only teaches a PDF file that is distributed to respective correctors using a communication line (col. 9 lines 18-21) and ILOG only states on page 3 that

"JRules 3.0 offers many features for developers that speed rule deployment and improve performance, including: ...

-- Automatic integration between the rule engine and relational databases, allowing users to define business

rules that reference data stored in RDBMS (relational database management systems)."

The ILOG reference nowhere discusses networked, distributed, replicated databases, as alleged by the Office Action.

With regard to the Office Action's allegation that it would have been obvious to one of ordinary skill to combine Kashino's publishing of ads and ILOG's software for creating business rules because one would have been motivated to implement ILOG's software to create business rules for Kashino's publishing of ads for the purpose of describing and controlling the structure, operation and strategy of the publication business. Applicants respectfully assert that since Kashino does nowhere teach the use of business rules for any purpose, let alone controlling the structure, operation and strategy of the publication business, it would not have been obvious how to modify Kashino to use ILOG's software, especially since Kashino is directed to a presentation apparatus for cooperative correction by a plurality of correctors of two-dimensional picture information and not to the structure, operation and strategy of the publication business.

Finally, Applicants assert that ILOG is a tool like a compiler or a relational database management system or a knowledge base combined with an inference engine. ILOG does not provide

business rules off-the-shelf, these rules have to be defined for each business and project, see brochure for Business Rules Workshop attached hereto as Attachment #1. And, just like a tool such as a compiler or a relational database management system or a knowledge base combined with an inference engine, does not render obvious all the software and hardware inventions that use a compiler, a relational database management system, or a knowledge base combined with an inference engine, neither does ILOG render obvious all inventions that use a tool such as ILOG to define and implement business rules. The Business rules express the constraints associated with a business method/process and ILOG is just a tool for capturing business rules via a special purpose language and implementing the captured business rules. The existence of a tool does not render obvious inventions that incorporate the product of the tool. Further, the ILOG press release references other exiting approaches to capturing and implementing business rules (page 1 last paragraph, page 2 paragraphs 2 and 4) which the Office Action did not cite as prior art in combination with Kashino as rendering the present invention of Claims 1 and 20 obvious. Assuming, arguendo, that ILOG in combination with Kashino renders the invention of Claims 1 and 20 obvious, why doesn't every other existing business rule tool do

likewise? Attachment #2 hereto is a webpage <http://www.eurobizrules.org/> for a business rules conference that provides links to fifteen providers of tools for engineering business rules, including the ILOG tools cited by the Office Action.

In view of all of the foregoing discussions, the Office Action has not made out a *prima facie* case of obviousness, the rejections should be withdrawn, independent Claims 1 and 20 are allowable, and Claims 2-19 and 21-26, respectively dependent therefrom, are allowable for at least this reason.

III. Claims 5-19 and 21-24 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kashino , in view of ILOG and further in view of Johnson et al (U.S. Patent No. 6,453,301, hereinafter "Johnson").

The Office Action Position

The Office Action admits that Kashino, as modified by ILOG, does not teach Ad Box default template defining a plurality of entries for each Ad Box instance or Ad Master template defining a plurality of components for each Ad Master instance; ... setting said status The Office Action alleges that Johnson teaches a presentation generation system that integrates customer specific information with a selling entity element to generate a presentation item for sale of product customized for a particular

customer of the selling entity (Abstract). The Office Action further alleges that Johnson teaches templates used to develop a presentation item (ad) such as programs, rules or instructions, where the templates include presentation format templates indicating the various information to be integrated to form a presentation item (ad). The presentation format template associate with rules defining for example, the layout of a presentation item which implies that templates [are] being controlled by associated business rules and [are] being defined by at least one of company advertiser and ad publisher. Johnson further alleges that it would have been obvious to one of ordinary skill in the art to modify Kashino's publication of ads by include (sic) Johnson's templates associated with and controlled by business rules in order to quickly and easily create the presentation (ad).

Applicants Response

The customer solution system 102 taught by Johnson generates a customized presentation, not an advertisement, of available products of a selling entity to be presented to a customer that is based on the customer's requirements for those products (customer specific information) (Abstract; col. 3, lines 23-51). If a customer is seeking to buy advertising the customer solution

system 102 product data may include advertisement medium, advertisement product features, advertisement length, broadcast time, broadcast coverage, etc. (col. 5, lines 53-56). FIG. 18A-O are examples of custom presentations for a sales proposal for advertising space in a newspaper, they are not the actual ads prepared for publication in at least one delivery medium as claimed by present claims 1-26.

The presentation system taught by Johnson supports a seller organization by generating custom presentations based on customer requirements for products sold by the sales organization. Johnson calls these presentations "proposals" because they are presented to the customers who requested them and are not published as advertisements (see, e.g., col. 2, line 2; FIG. 18A-O; FIG. 19A-P; FIG. 20A-N; col. 3, lines 29, 60, & 65; col. 4, lines 41; col. 6, lines 42 & 54).

Thus, Johnson does not cure the admitted deficiencies of Kashino.

In addition, as discussed above, Kashino has several other deficiencies, and Johnson also does not cure these other deficiencies.

Therefore, the Office Action has failed to make out a *prima facie* case of obviousness, the rejections should be withdrawn,

Claims 5-19 and 21-24 are allowable.

Conclusion

For at least the above reasons, it is respectfully submitted that all ground of rejection stated in the Office Action have been overcome. A Notice of Allowance is respectfully requested.

If any issues remain which may be best resolved through a telephone communication, the Examiner is requested to kindly telephone the undersigned at the local, Silver Spring, MD telephone number listed below.

Respectfully submitted,



Noreen O. Welch
Registration No. 45,208

Date: May 6, 2003

NOW/att

encl: (1) Business Rules Workshop Brochure
(2) web page for European Business Rules Conference citing
suppliers of business rules tools

Attorney Docket No. NOW0730

Law4IP
94 Eldrid Drive
Silver Spring, MD 20904-2912

Telephone: (301) 622-4319
Facsimile: (301) 622-0694



Zürich, 10 - 12 June 2003



Born  **Informatik**



Computer Associates



EVEREST[®]



European
Business Rules



Model Systems



2003



Programme Conference Tutorials



Media Sponsor



attachment #2